

REMARKS/ARGUMENTS

Status of Claims

Claims 9-14, 24-27 and 29 are currently pending in the application. Claims 9, 24, and 29 have been amended. No claims have been cancelled or added. Therefore, claims 9-14, 24-27 and 29 are present for examination. No new matter is added by these amendments. Claims 9, 24, and 29 are independent claims. Applicant respectfully requests reconsideration of this application as amended.

35 U.S.C. §103 Rejections

Claims 9-10, 12, 24-25, 27 and 29 were rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application Publication No. 2003/0225708 A1 to Park et al. (“**Park**”) in view of U.S. Patent No. 5,878,141 to Daly et al. (“**Daly**”). Applicants respectfully traverse the obviousness rejection. To establish a *prima facie* case of obviousness, all claim limitations must first be taught or suggested by the prior art. *See, e.g., DyStar Textilfarben GmbH & Co. Deutschland KG v. C.H. Patrick Co.*, 464 F.3d 1356, 1360 (Fed. Cir. 2006). “All words in a claim must be considered in judging the patentability of that claim against the prior art.” M.P.E.P. § 2143.03 (*citing In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)). The Examiner must then provide an explicit analysis supporting the rejection. *See KSR Int’l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (“a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art”). While the Examiner can choose one of several exemplary rationales from the MPEP to support an obviousness rejection under *KSR*, all the rationales still require the Examiner to demonstrate that all the claim elements are shown in the prior art. *See* MPEP § 2143, Original Eighth Edition, August 2001, Latest Revision July 2008.

Claim 9:

Missing Limitation: “a check authorization system identifying two or more check issuers in a desired geographical location”

Claim 9 requires “a check authorization system identifying two or more check issuers in a desired geographical location.” Here, *a check authorization system* identifies *check issuers*. The Examiner admits that Park does not teach this limitation. See *Office Action*, p. 3. Rather, the Examiner relies on Daly to provide the missing description. The section cited in Daly is as follows: “The department store, on the other hand, might only accept a few of these forms of payment, such as cash, *local checks*, its own charge card, and American Express®, while not accepting other forms of payment.” *Daly*, col. 1, lines 37 (*emphasis added*). It should be noted that the Examiner focuses heavily on the mention of “local checks.” See *Office Action*, p. 3.

There are several problems with the description in Daly. First, a department store, a merchant, and not a check authorization system, is determining if the check is local. As such, the wrong entity is performing the function recited in the claim. Next, the department store is determining if a check or check presenter is local and not the check issuer. As such, the department store is performing a function different from that recited in the claim. Finally, there is no mention of identifying as a function at all. How does the two word phrase “local checks” actually describe identifying check issuers in a desired location?

For at least this reason, claim 1 is allowable over the prior art.

Missing Limitation: “the check authorization system obtaining, from two or more check issuers, identifiers for checking accounts associated with the two or more check issuers”

Claim 9 also requires “the check authorization system obtaining, from two or more check issuers, identifiers for checking accounts associated with the two or more check issuers.” Here, *a check authorization system* obtains identifiers of accounts from *two or more check issuers*. The Examiner relies on Park to show this limitation. See *Office Action*, p. 3. The section cited in Park is as follows:

To verify the secure negotiable instrument 32, the operator of the check verification system 24 may first insert the bottom edge of the secure negotiable instrument 32 into the MICR reader 26 such that the MICR reader 26 will read the

routing code, the account number, and the check number from the MICR zone 34 across the bottom edge of the secure negotiable instrument 32 and may then insert the top edge of the secure negotiable instrument 32 into the MICR reader 26 such that the MICR reader 26 will read the numeric sequence 44 of the second line of MICR characters inverted within the MICR zone 42 across the top edge of the negotiable instrument 32. The routing number, the account number, the check number, and the numeric sequence 44 may be presented to the verification engine 28.

Park, ¶ [0130].

Step 176 represents receiving the numeric sequence 44 from the MICR reader 26 and step 178 represents receiving the routing number, account number, and check number from the MICR reader 26

Park, ¶ [0134].

Again, there are several problems with this description in *Park*. First, a check verification system, and not a check authorization system, obtains the identifiers. A check verification system in *Park* is the system that is present with a negotiable instrument for payment. *See Park*, ¶ [0038] (“When a secure negotiable instrument is presented for payment at one of the check verification systems 24, the check verification system 24 will query the secure directory server 22 to obtain a network address or universal resource locator (URL) of the payment system 14a, 14b, and 14c that issued the secure negotiable instrument 32.”). Again, the wrong entity is performing the function recited in the claim. Next, the check verification system is obtaining an identifier from a check and not from a check issuer. *See Park*, ¶ [0130] (“To verify the secure negotiable instrument 32, the operator of the check verification system 24 may first insert the bottom edge of the secure negotiable instrument 32 into the MICR reader 26 such that the MICR reader 26 will read the routing code, the account number, and the check number . . .”). The check verification system is performing a function different from that recited in the claim. Finally, the check verification system is obtaining only one identifier and not identifiers for two or more check issuers.

For at least this reason, claim 1 is allowable over the prior art.

Missing Limitation: “the check authorization system compiling on a computer-accessible storage medium a repository of records, wherein a record comprises information to identify a check issuer name, an associated check issuer's location, and the associated check issuer's checking account”

Claim 9 requires “the check authorization system compiling on a computer-accessible storage medium a repository of records, wherein a record comprises information to identify a check issuer name, an associated check issuer's location, and the associated check issuer's checking account.” The Examiner admits that Park does not teach a record comprising a check issuer name and the associated check issuer's location. *See Office Action*, p. 3. Rather, the Examiner relies on Daly to provide the missing description. The section cited in Daly is as follows: “The department store, on the other hand, might only accept a few of these forms of payment, such as cash, *local checks*, its own charge card, and American Express®, while not accepting other forms of payment.” *Daly*, col. 1, lines 37 (*emphasis added*). It should be noted that the Examiner again focuses heavily on the mention of “local checks.” *See Office Action*, p. 3.

However, this section of Daly does not mention anything about creating a record or adding information to a database. Indeed, Daly only states the term “local checks.” Yet, this simple disclosure does not describe adding a check issuer name and location to a database. Thus, the Examiner has not provided a reference to provide description covering this element of the claims. Therefore, the Examiner has failed to state a *prima facie* case of obviousness.

For at least this reason, claim 1 is allowable over the prior art.

Claims 37-43:

Claims 37-43 each depend, either directly or indirectly, from allowable independent claim 36. “If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.” M.P.E.P. § 2143.02 (*citing In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). Therefore, claims 37-43 are also allowable over the cited art due, at least in part, to this dependence on an allowable base claim.

Claims 10-14:

Claims 10-14 each depend, either directly or indirectly, from allowable independent claim 9. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." M.P.E.P. § 2143.02 (*citing In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). Therefore, claims 10-14 are also allowable over the cited art due, at least in part, to this dependence on an allowable base claim.

Claim 24:

Claim 24 includes the same or similar limitations to allowable claim 1. The Examiner explicitly recognizes this similarity. *See Office Action*, p. 4. Thus, claim 24 is allowable over the cited art for the same or similar reasons.

Claims 25-27:

Claims 25-27 each depend, either directly or indirectly, from allowable independent claim 24. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." M.P.E.P. § 2143.02 (*citing In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)). Therefore, claims 25-27 are also allowable over the cited art due, at least in part, to this dependence on an allowable base claim.

Claim 29:

Claim 29 includes the same or similar limitations to allowable claim 1. The Examiner explicitly recognizes this similarity. *See Office Action*, p. 4. Thus, claim 29 is allowable over the cited art for the same or similar reasons.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested. Applicants do not acquiesce to any objection, rejection, or argument not specifically addressed herein. Rather, the Applicants believe the amendments and arguments contained herein overcome all objections, rejections, or arguments.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 303-571-4000.

Respectfully submitted,



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